

Response to Office Action dated May 9, 2007
U.S. Serial No.: 10/518,171; filed August 23, 2005
Inventor: Schennach et al
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REMARKS

Entry of the amendments is respectfully requested. Claims 5 and 12 have been amended with this response. New claims 15-20 have been added. Claims 1-20 are pending and presented for review. Favorable reconsideration and allowance of this application is respectfully requested in light of the foregoing amendments and the remarks that follow.

1. Request for Withdrawal of Holding of Finality

The Office Action indicates that this rejection is a final rejection. Applicant respectfully requests that this holding be withdrawn because the Examiner introduced a new ground for rejecting the claims not necessitated by amendment. Specifically, the Examiner has rejected claims 1-4, 6-10 and 12-14 [sic: 11, 13, and 14] based, in part, on newly cited prior art, namely U.S. Patent No. 2,856,828 to Brown et al.

Under MPEP § 706.07(a), a “...subsequent action on the merits in any application...will not be made final if it includes a rejection, on newly cited art, other than information submitted in an IDS...of *any* claim not amended by applicant...in spite of the fact that other claims may have been amended to require newly cited art.” Independent claim 1 and dependent claims 2-4, 6 and 7 were not amended, nor was Brown et al. cited in any IDS. Therefore, the holding of finality is premature and should be withdrawn. New claims 15-20 therefore are entitled to entry as a matter of right.

2. Rejections Based on Prior Art

a. Rejections Under 35 USC § 103(a)

Claims 1-4, 6-10, and 12-14 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,551,022 to Stayner (Stayner), in view of U.S. Patent No.

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3,232,188 to Frohnauer (Frohnauer). Claims 1-4, 6-10, and 12-14 [sic: 11, 13, and 4]¹ also stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stayner in view of newly cited U.S. Patent No. 2,856,828 to Brown et al.(Brown).

Applicants respectfully traverse the above referenced rejections and re-asserts that the Examiner misinterpreted and misapplied Frohnauer and Brown. Neither the cited combination of Stayner and either Frohnauer or Brown, nor any other reference of record, alone or in combination, disclose each and every element of the novel independent claims.

First, the geometry of

Independent claims 1 and 8 recite a soil compacting device that includes an undercarriage having one or more roller elements situated in rotatable fashion on an undercarriage axle for the transport of the device, wherein the undercarriage axle is stationary, i.e., remains fixed in place and does not rotate, in relation to the device. A combination of the Stayner patent and either Frohnauer or Brown does not and cannot suggest an undercarriage assembly where the undercarriage axle is stationary in relation to the device.

The Examiner states that “the axle assembly of Frohnauer appears to be fixed relative to the device.” Applicants respectfully disagree with the Examiner that the Frohnauer patent teaches or even somehow suggests a stationary axle as claimed. (May 9, 2007 Office Action, page 5). As previously argued, what the examiner asserts is a wheel, i.e., the structure identified with reference number 21 in Figure 1 of Frohnauer, is not described, at all, in the text of Frohnauer. There is even less disclosure of how the structure 21 is mounted to the device. If structure 21 does rotate, as asserted by the Examiner, there is no disclosure to indicate whether the structure 21 is connected to either a straight (i.e., rotating) axle or a

¹ The reference to claim 12 is believed to be a typographical error on the part of the Examiner since claim 12 is commensurate in scope with claim 5, which the Examiner has indicated as being allowable. Claim 11, on the other hand, is commensurate in scope with claim 4, which the Examiner rejected. This response is presented on the assumption that the Examiner intended to reject claim 11 and indicate that claim 12 is allowable. Applicant informed the Examiner of this assumption via a voicemail on today's date.

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fictive (i.e., stationary) axle. Brown also fails to disclose any structural components of the axle. The present invention, as described in claims 1 and 8, includes a stationary axle. Neither the Frohnauer device nor the Brown device discloses a stationary axle, and to suggest otherwise is merely conjecture.

Accordingly there is no motivation or suggestion, short of improper hindsight reconstruction based on applicants' own disclosure, to interpret Frohnauer or Brown as the Examiner proposes, or to combine Frohnauer or Brown with Stayner and modify that combination, to arrive at the device recited in claim 1. Claim 1 is therefore believed to be non-obvious over the cited prior art ending condition for allowance.

Nor is there any suggestion, short of improper hindsight reconstruction based on applicants' own disclosure, to combine Stayner and either Frohnauer or Brown to produce the devices recited in claims 2-4, 6, 7, 9-11, 13, and 14, respectively.

For these reasons, Stayner and either Frohnauer or Brown, combined, do not render the invention of independent claim 1 obvious and therefore the rejections should be withdrawn. The rejection of claims 2-4, 6-10, and 12-14, each of which dependent directly or indirectly on claim 1, should likewise be withdrawn.

b. Claims with Allowable Subject Matter

In the Office Action, the Examiner indicated that claims 5 and 11 [sic: 12] would be allowable if rewritten in independent form. Applicants sincerely thank the Examiner for such indication. Claims 5 and 12 have been rewritten in independent form and now include all the limitations from the base and any intervening claims. Accordingly, claims 5 and 12 are now believed to be in allowable form as indicated by the Examiner.

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2. New Claims

New claims 15-17 dependent from claim 1 and claims 18-20 dependent from claim 8 recite additional features of the invention neither disclosed by nor suggested by the cited prior art. For instance, all of the new claims require that at least part of each rolling element be positioned in front of the rear edge of the compacting plate, with claims 16 and 19 additionally requiring that the rolling elements must be positioned at least in part in notches in rear corners of the compacting plate. Positioning the rolling elements in this manner reduces the footprint of the machine and permits bearer elements forming one embodiment of the stationary axle to be mounted on the compacting plate itself (see, .e.g., the elements 8a and 8b in Fig. 2). The thus-mounted bearer elements are recited in claims 17 and 20. Such a configuration is not disclosed or suggested by the cited prior art.

2. Conclusion

In light of the foregoing remarks and amendments, it is submitted that Claims 1-14 are in compliance with 35 USC § 103 and each define patentable subject matter. A Notice of Allowance is therefore respectfully requested.

No fees are believed due with this communication. Nevertheless, should the Examiner consider any other fees to be payable in conjunction with this or any future communication, the Director is authorized to direct payment of such fees, or credit any overpayment to Deposit Account No. 50-1170.

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The Examiner is strongly urged to contact Applicants' attorney by telephone with any remaining questions, if such telephone contact would help expedite allowance of the claims.

Respectfully submitted,



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